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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/792,046 | 03/03/2004 | Edward John Bright | 18121 (AT 20958-2129) | 4749 |

7590 05/09/2005

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EXAMINER

CHERVINSKY, BORIS LEO

ART UNIT

PAPER NUMBER

2835

DATE MAILED: 05/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

EX

| | | | |
|------------------------------|---------------------------------|-------------------------------------|--|
| Office Action Summary | Application No. 10/792,046 | Applicant(s) BRIGHT, EDWARD JOHN | |
| | Examiner Boris L. Chervinsky | Art Unit 2835 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5-8,11-13 and 17-20 is/are rejected.
- 7) ☒ Claim(s) 2-4,9,10 and 14-16 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 5-7, 8, 11, 12, 13, 17-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bianchini et al. in view of Amorim.

Bianchini discloses an electronic transceiver assembly, comprising: a of guide frame 14, the guide frames having top, bottom and side walls joined to form an interior cavity and having a heat sink opening (not numbered, see Fig. 4) extending through one of top, bottom and side walls; a transceiver 24 configured to be received in the guide frame 14; a heat sink (not numbered) mounted over the guide frame and extending through the sink opening, the heat sink having an engagement surface located proximate the interior cavity of the guide frame, the engagement surface of each heat sink being configured to physically contact the transceiver when installed in the interior cavity; and a heat sink clip (not numbered) spanning the guide frame; the engagement surface of the heat sink rests within the interior cavities of the guide frame at a level that interferes with an installation path of the transceiver, the heat sink being movable outward by the transceiver when the transceiver is installed to provide an abutting interface between the heat sink and the transceiver; the engagement surface of the heat sinks is flat and smooth to slide along a mating surface of the transceiver when installed. Bianchini

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discloses the claimed invention except the plurality of the guide frames. Amorim discloses a plurality of guide frames to accommodate a plurality of modules. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to have a plurality of guide frame as disclosed by Amorim in the structure disclosed by Bianchini to accept a plurality of the modules, besides, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a plurality of frames, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8. The details written to the rate of transmittal of the transceiver, which is irrelevant to the structure as claimed, or to the number of the guide frames to be four is not proven to be critical for the invention therefore it is obvious.

Allowable Subject Matter

3. Claims 2-4, 9, 10, 14-16 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The following is a statement of reasons for the indication of allowable subject matter: the prior art is silent regarding the plurality of the interposer spring elements in contact with the heat sink clip and exerting a clamping force on the plurality of heat sinks.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1, 5-7, 8, 11, 12, 13, 17-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,816,376 in view of Amorim. Amorim discloses a plurality of guide frames to accommodate a plurality of modules. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to have a plurality of guide frame as disclosed by Amorim to accept a plurality of the modules, The patent shows the plurality of slots to accommodate the plurality of guide frames, therefore this particular feature could be claimed in the patent; besides, it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. *St. Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Boris L. Chervinsky whose telephone number is 571-272-2039. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynn D. Feild can be reached on 571-272-2800 ext. 35. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BORIS CHERVINSKY
PRIMARY EXAMINER

Boris L. Chervinsky
5/5/5